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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,551	03/21/2001	Tetsuo Nakata	826.1711/JDH	2646

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EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,551

Applicant(s)

NAKATA ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/16/2004 has been entered.

Claim 2 was canceled via the applicant's amendment filed 6/16/2004. Claims 1 and 3-13 are pending in the instant application.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 12-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Referring to claims 12-13. A computer data signal or a transmission medium per se is not the type of subject matter that is considered statutory. If the signal or transmission medium claim is interpreted as an abstract arrangement "to be transmitted", or as a transmission in transit, rather than a physical signal statically embedded in a physical computer readable medium, the signal claim is considered non-statutory.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 and 2-7 are rejected under 35 U.S.C. 112 second paragraph.**

Referring to claims 1 and 2-7. Claims 1 and 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 (independent) and claim 7 (independent) were amended wherein the applicant deleted the word "work" after "literary" in the first line of the preamble (both claim 1 and claim 7). The deletion of the word "work" is grammatically incorrect and causes insufficient antecedent basis for "literary work" in subsequent claim limitations.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 3-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Glassman U.S. Patent No. 6,453,305.**

Referring to claim 1. Glassman discloses a sales method for selling a literary work, comprising:

- Selling the literary work to a purchaser using a computer based sales device to communicate over a communication network with the purchaser at a computer based purchaser device (column 4, lines 7-15);
- Associating information about the literacy work and information about a purchaser that has purchased said literary work (column 4, lines 45-62); and

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- Providing said associating information via the network (column 5, lines 8-15) and wherein the literary work is sold per units of rights on a copyright of the literacy work (column 5, lines 34-56).

Referring to claim 3. Glassman further discloses a sales method wherein the information about the purchaser is provided per units of the sold rights (column 5, lines 34-56).

Referring to claim 4. Glassman further discloses a sales method comprising:

- Notifying a seller of the literary work of rights based on the copyright corresponding to a type of the literary work (column 6, lines 20-49); and
- Obtaining from the seller information about the right to be sold, from the notified rights (column 6, lines 20-49).

Referring to claim 5. Glassman further discloses a sales method wherein the information about the purchaser is provided to an arbitrary person (Figure 2, "BANK").

Referring to claim 6. Glassman further discloses a sales method wherein the information about the purchaser is provided after payment of a purchaser price is confirmed (column 5, lines 34-56).

Referring to claim 7. Glassman discloses a purchase method for purchasing a literary work, comprising:

- Purchasing the literary work by a purchaser using a computer based sales device to communicate over a communication network with the purchaser at a computer based purchaser device (column 4, lines 7-15); and

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- Being authenticated to be a purchaser of the literary work by publicizing the fact via a network (column 5, lines 34-56), and
- Wherein the literary work is sold per units of rights based on a copyright of the literary work (column 5, lines 34-56).

Referring to claim 8. Claim 8 is rejected under the same rationale as set forth above in claims 1 and 2-5.

Referring to claim 9. Claim 9 is rejected under the same rationale as set forth above in claims 1 and 2-5.

Referring to claim 10. Claim 10 is rejected under the same rationale as set forth above in claims 1 and 2-5.

Referring to claim 11. Claim 11 is rejected under the same rationale as set forth above in claims 1 and 2-5.

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claims 1 and 2-5.

Referring to claim 13. Claim 13 is rejected under the same rationale as set forth above in claims 1 and 2-5.

### ***Response to Arguments***

Applicant's arguments filed January 5, 2004 are moot in view of the new grounds of rejection.

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***Conclusion***

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MSG  
Patent Examiner  
September 12, 2004